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DOCKET NO.: 9491-013-27

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Re: Serial No.: 09/138,091  
Applicant(s): CAMELLIA W. ADAMS, ET AL.  
Filing Date: AUGUST 21, 1998  
For: AGONIST ANTIBODIES  
Group Art Unit: 1647  
Examiner: SPECTOR, L.

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO COMMUNICATION**

Our check in the amount of \$ -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary extension of time to make the filing of the attached documents timely, please charge or credit the difference to Deposit Account No. 50-1442. Further, if these papers are not considered timely filed, then a request is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Steven B. Kelber  
Attorney of Record  
Registration No.: 30,073

Perry E. Van Over  
Registration No.: 42,197



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: CAMELLIA W. ADAMS, ET AL. GAU: 1647  
SERIAL NO: 09/138,091 EXAMINER: SPECTOR, L.  
FILING DATE: AUGUST 21, 1998  
FOR: AGONIST ANTIBODIES

**RESPONSE TO COMMUNICATION**

#31  
S.Q.J  
10/16/02

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Sir:

The Applicants' filed an Appeal Brief in the above reference application on August 26, 2002. The Examiner's response of September 10, 2002, partially addressed the issues on appeal by withdrawing the rejection of Claim 49 under 35 U.S.C. § 112, first paragraph. The Examiner did not respond to the remaining issues of the Examiner's contention that claims 46-48, 49, and 50-57 contain improper Markush groups.

The Examiner's refusal to fully examine the Markush claims on the merits as required by the U.S. Patent and Trademark guidelines is precisely the position that the Court of Customs and Patent Appeals addressed in In re Haas, 580 F.2d 461 (CCPA 1978). The Court also discussed this improper treatment of Markush type claims in its decision of In re Harnisch., 631 F.2d 716 (CCPA 1980). The Court stated:

In the PTO, patent applications are examined for compliance with the statutory provisions of Title 35, United States Code, as set forth in sections 100, 101, 102, 103, and 112. These are considered to be examinations "on the merits." There are also procedural questions arising under section 121 and related PTO rules concerned with "restriction practice." ... As shown by the *In re Haas* cases, issues arose from PTO refusal to consider on the merits single claims to groups of chemical compounds of broad scope unless each claim was first broken up into a plurality of claims of lesser scope. The first PTO position was that it would neither consider nor reject the claims, thus foreclosing appeal to the board or to this court. After this position was held to be a rejection, the PTO promulgated its May 1, 1974 Notice, which authorized rejection on the basis of § 121, relating to restriction, thus combining the two matters of Markush practice and restriction practice. In *Haas II* (see note 6, *supra*), this court held that § 121 could not be used as the basis for rejecting a single claim or compelling its replacement by a plurality of narrower claims before examination on the merits would be made. (Emphasis added)

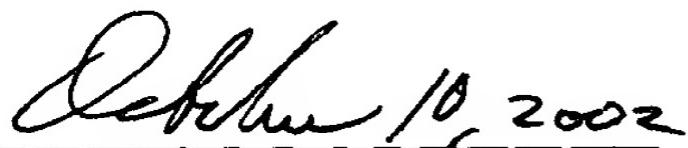
Thus the Court has held the action of neither considering nor rejecting the claims so as to foreclose appeal to the board and/or the court are, in fact, a rejection. The position taken by the Examiner in the present case is identical to that discussed above regarding In re Haas and, as such, the claims stand rejected by the Examiner and are therefore appealable issues.

Accordingly, the Appellants respectfully submit that the Appeal Brief of August 26, 2002 does have appealable issues remaining which properly must be submitted by the Examiner to the Board of Patent Appeals and Interferences.

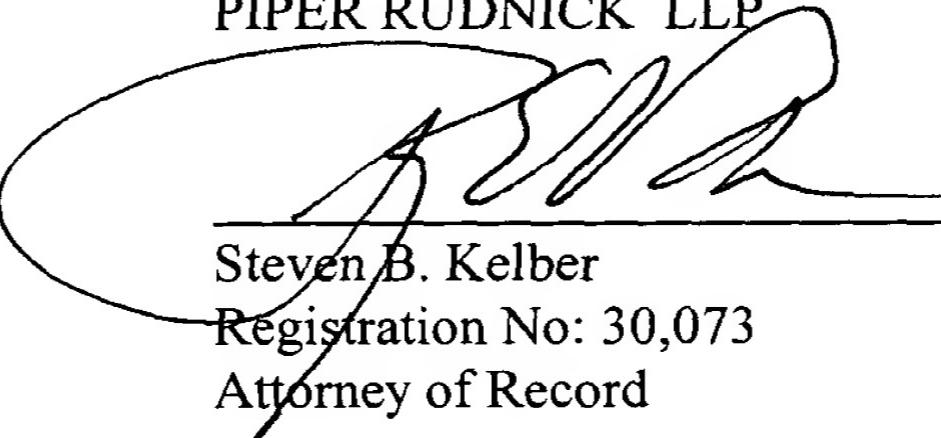
Submission of the Applicants' Appeal to the Board of Patent Appeals and Interferences  
without further delay is respectfully requested.

Respectfully submitted,

PIPER RUDNICK LLP



Date



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